

Appl. No. 10/014,934

Amdt. dated July 31, 2007

Reply to the Final Office Action of June 4, 2007

AFTER FINAL EXPEDITED PROCEDURE

REMARKS

Claims 1 to 25 were pending in the application at the time of the final action. Claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 14, 17, 19, 20, 22, 23 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable.

Claims 4, 10, and 16 are amended. The amendment restores text that was inadvertently deleted by the prior amendment. Accordingly, the amendments do not raise new issues and do not require a new search. Entry of the amendments under Rule 116 is respectfully requested.

Claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 14, 17, 19, 20, 22, 23 and 25 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Publication No. 2001/011250 by European Patent Publication No. 0855659 A1 of Palthenghe, hereinafter referred to as Pal.

Applicants respectfully traverse the obviousness rejection of each of Claims 1, 4, 7, 10, 13, 16, 19, and 22. As explained more completely below, the rejection extracts pieces from Pal out of context, e.g., from an Information Bank, changes the operation of the pieces as defined by Pal for the Information Bank, and then inserts the modified pieces into a different environment than that for which Pal used the pieces.

The MPEP is unambiguous. A reference must be considered as a whole. Interpreting a reference properly is required and when this is not done, a prima facie obviousness rejection has not been made. The MPEP requires:

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.

MPEP § 2141.02, 8th Ed., Rev. 5, p. 2100-124 (August 2006).

Moreover, express claim limitations have been ignored. The claim language was reduced to a gist and that gist was

GUNNISON, MCKAY &
HODGSON, L.L.P.
Garden West Office Plaza
1000 Garden Road, Suite 220
Menlo Park, CA 94025
(415) 655-0888
Fax (415) 655-0888

JUL 31 2007

Appl. No. 10/014,934

Amdt. dated July 31, 2007

Reply to the Final Office Action of June 4, 2007

AFTER FINAL EXPEDITED PROCEDURE

rejected. This level of analysis violates the MPEP requirements.

II. DISTILLING THE INVENTION DOWN TO A "GIST" OR "THRUST" OF AN INVENTION DISREGARDS "AS A WHOLE" REQUIREMENT

Distilling an invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the subject matter "as a whole."

MPEP § 2141.02, 8th Ed., Rev. 5, p. 2100-122 (August 2006). Thus, the MPEP expressly provides that distilling the express claim limitation to a gist is error.

These errors demonstrate that a prima facie obviousness rejection has not been made. Finally, the rejection is based on improper official notice.

As an example for this set of claims, Claim 1 recites in part:

requesting, by a browser accessing a network site and executing on a processor, ... from another device (i) different from said user-controlled resource-constrained device and (ii) included in a device including said processor

Thus, Claim 1 expressly recites that the browser is executing on a processor and that the processor is included in a device. The browser makes the request to another device included in the device with the processor. Thus, the plain meaning of these claims is that the browser, the processor, and the another device are all defined as being in the same device.

In addition, the browser is not just some browser in the abstract, but rather "a browser accessing a network site," the browser requests "user data . . . when said network site requires said user data." In addition, the browser performs two alternative actions,

Appl. No. 10/014,934

Amdt. dated July 31, 2007

Reply to the Final Office Action of June 4, 2007

AFTER FINAL EXPEDITED PROCEDURE

requesting . . . user data from a user-controlled resource-constrained device,

and if the request is unsuccessful, "said browser requesting said user data from another device."

Thus, the browser on the device first queries the user-controlled resource-constrained device, and if that query is unsuccessful, the browser requests the user data from another device that is located on the same device on which the browser is executing. Thus, a browser performs all the operations and determines what actions to take.

The rejection confuses actions taken by the Information Bank of Pal with the electronic wallet of Pal and fails to track consistently what Pal taught as performing which actions. In fact, as noted below, when Pal is considered as a whole, Pal teaches away from the interpretation in the rejection.

The rejected stated in part:

requesting, by a browser accessing a network site (parag. 46, where consumer information is requested by various merchants. Note that as mentioned above, Pal teaches use of Internet and browser for exchanging data), and executing on a processor (Browsers run on a hardware platform which contains a processor)

Paragraph [0046] of Pal fails to teach or suggest anything concerning the browser or device on which the browser is executing as recited in these claims. Requesting data from the Information Bank by merchants has nothing to do with the requests made by a browser on a specific device. Thus, a request operation by a specific device by a specific element as recited in these claims has been reduced to a gist, any request to a network site by merchants.

Similarly, a browser executing on a specific device is reduced to a gist of some browser executing on a device in general. There has been no showing or suggestion of a browser

GUNNISON, MCKAY &
HODGSON, L.L.P.
Garden West Office Plaza
1900 Garden Road, Suite 720
Menlo Park, CA 94025
(831) 655-0880
Fax (831) 655-0888

Appl. No. 10/014,934

Amdt. dated July 31, 2007

Reply to the Final Office Action of June 4, 2007

AFTER FINAL EXPEDITED PROCEDURE

executing on one device that requests user data from the electronic wallet of Pal.

The rejection continues the mischaracterization of Pal by stating:

Parag. 60 shows an example when the backup user data is requested from the Information Bank. Note that, as mentioned above, the data stored on the Information Bank is also stored on the smart card)

Paragraph [0060] of Pal is not discussing the electronic wallet, but rather issues that arise when the user stores keys needed to decrypt data on a hard drive that fails. Specifically,

[0060] Both Netscape and Microsoft Corporations market web browsers which currently provide support for generating key pairs. However, if a user is so unfortunate as to suffer a disc crash or has failed to update the browser software, it is possible that a user could lose the keys forever. Once this happens, there is no way to retrieve the information previously encrypted with the keys. The information bank 23 may offer a key escrow and recovery function as further depicted in FIG. 6 to protect the consumer 25 against catastrophic key losses. In FIG. 6 the consumer 25 uses software, such as a browser, which can generate a key pair generation request and forward it to the information bank 23. The information bank 23 then generates a key pair and certificate, saves the key pair and certificate, and forwards them to the consumer 25 for use. A second option is shown in FIG. 7 in which the consumer 25 using browser software, generates the key pair and certificate and then forwards the key pair and certificate to the information bank 23 for archival. If the consumer 25 ever loses a key pair, the consumer 75 can request and receive a replacement copy from the information bank 23. To accomplish all of this, of course, cryptographic software 39 is required, the details of which will be readily apparent to those of ordinary skill in the art.

Thus, paragraph [0060] of Pal not only fails to support the interpretation in the rejection, but teaches away from the invention of these claims. Paragraph [0060] teaches that when

GUNNISON, MCKAY &
HODGSON, L.L.P.
Garden West Office Plaza
1900 Garden Road, Suite 220
Menlo Park, CA 94025
(773) 655-0888
Fax (773) 655-0888

Appl. No. 10/014,934

Amdt. dated July 31, 2007

Reply to the Final Office Action of June 4, 2007

JUL 31 2007

AFTER FINAL EXPEDITED PROCEDURE

information, not from a user-controlled resource-constrained device, but from a hard drive cannot be retrieved, the Information Bank "may offer a key escrow and recovery function." This teaches that when information is unavailable on a hard drive, and not the electronic wallet cited, the effort is not directed towards the device on which the browser is executing, but rather over a network to the Information Bank of Pal. The very information relied upon in the rejection teaches away from the interpretation given in the rejection.

Further, the rejection takes the information out of context and mischaracterizes the teachings. To arrive at the interpretation in the rejection, information about a hard drive failure in paragraph [0060] has to be taken and applied to the electronic wallet, and the Information Bank has to be changed to the hard drive on the device on which the browser is executing. The rejection has not cited any justification for such modifications.

The rejection continues to ignore specific claim limitations. Specifically, the rejection continued:

(Examiner takes the official notice that the limitation is trivial. This is because the determination that said user data is unavailable from said user controlled-resource- constrained device is made after the request is made to the device. Also, the request to any 'other device is made after it is determined that the data is not available on the user controlled-resource- constrained device. Therefore, when the requested data is not available on the user controlled-resource-constrained device, the request to any other device is after the request to the user controlled-resource-constrained device. Further note that when the data request from a device is unsuccessful, requesting data from a different device located on the same system was well known and widely practiced by the one skilled in art at the time of invention.)

Applicants traverse this use of Official Notice.

Moreover, contrary to the triviality, Pal taught an independent

GUNNISON, McKay &
HODGSON, LLP
Garden Way Office Plaza
1900 Garden Road, Suite 220
Menlo Park, CA 94025
(831) 655-0880
Fax (831) 655-0888

Appl. No. 10/014,934

Amdt. dated July 31, 2007

Reply to the Final Office Action of June 4, 2007

AFTER FINAL EXPEDITED PROCEDURE

Information Bank on a network to address issues when information could not be found on a device, such as in the cited paragraph [0060] of Pal. The Information Bank of Pal cannot be characterized as a triviality.

Moreover, as explained above, in these claim, it is a browser that does the alternative efforts to locate the information. To use Official Notice, the Examiner must demonstrate that it was well known to have a browser search across multiple devices in response to a request from a network site for user data. Reducing the explicit claim limitations to a gist, "the data request from a device is unsuccessful, requesting data from a different device located on the same system was well known" and then using Official Notice with respect to the gist is improper. In general, if a browser is provided a URL and the file at the location addressed by the URL is not found, the browser simply issues an error. If the Examiner alleges some alternative browser behavior is routine, a reference is required. The rejection has failed to cite any teaching of a request for user information by a network site to a browser and the browser searching for the information on other than the device on which browser is executing. A user taking an action teaches away from a browser doing the action. Therefore, on multiple levels, the Official Notice is not well founded.

Only one of the above distinctions is needed to overcome the obviousness rejection of each of these claims. Applicants request reconsideration and withdrawal of the obviousness rejection of each of Claims 1, 4, 7, 10, 13, 16, 19, and 22.

Applicants respectfully traverse the obviousness rejection of each of Claim 2, 5, 8, 11, 14, 17, 20 and 23. The above remarks with respect to a resource-constrained device and browser with respect to Claim 1 are incorporated herein by reference. Applicants note the rejection has failed to cite

GUNNISON, MCKAY &
HODGSON, LLP
Garden West Office Plaza
1900 Garden Road, Suite 220
Menlo Park, CA 94025
(831) 655-0880
Fax (831) 655-0889

JUL 31 2007

Appl. No. 10/014,934

Amdt. dated July 31, 2007

Reply to the Final Office Action of June 4, 2007

AFTER FINAL EXPEDITED PROCEDURE

any request by a browser to a user-controlled resource-constrained device.

Moreover, in these claims the actions are performed on the user-controlled resource-constrained device. In contrast, the rejection ignores the fact that the cited actions are performed on the Information Bank that is taught as accessed by various merchants or service providers.

There has been no showing or teaching that the processes of the Information Bank with respect to static and dynamic data are, or could be, implemented on the electronic wallet of Pal that the rejection identified as the user-controlled resource-constrained device. Thus, again numerous modifications are required to take the teachings concerning the Information Bank and apply those teachings in a completely different environment, the electronic wallet of Pal. In fact, the use of the Information Bank teaches away from such an approach. Applicants request reconsideration and withdrawal of the obviousness rejection of each of Claims 2, 5, 8, 11, 14, 17, 20 and 23.

Applicants respectfully traverse the obviousness rejection of Claim 25. Paragraph [0030] describes an operation taken by the Information Bank. Since the Information Bank performs the operation, there is no need for the smart card of Claim 25. Therefore, Pal again teaches away. Applicants respectfully request reconsideration and withdrawal of the obviousness rejection of Claim 25.

//

//

//

//

//

//


Appl. No. 10/014,934
Amdt. dated July 31, 2007
Reply to the Final Office Action of June 4, 2007

AFTER FINAL EXPEDITED PROCEDURE

Claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 14, 16, 17, 19, 20, 22, 23 and 25 remain in the application. Claims 4, 10, and 16 have been amended. Claims 3, 6, 9, 12, 15, 18, 21 and 24 are cancelled. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

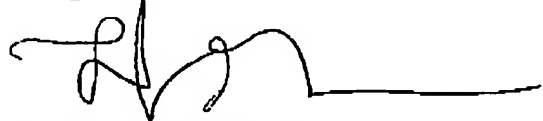
CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office, Fax No. (571)273-8300, on July 31, 2007.


Mona Marshall

July 31, 2007
Date of Signature

Respectfully submitted,



Forrest Gunnison
Attorney for Applicant(s)
Reg. No. 32,899